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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,349	07/28/2003	Richard J. Korane	T0520.70001US00	6347
7590	02/27/2006		EXAMINER	CHEN, VIVIAN
Randy J. Pritzker Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue Boston, MA 02210			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/629,349	KORANE ET AL.	
Examiner	Art Unit		
Vivian Chen	1773		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 27 January 2006.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-42 is/are pending in the application.  
4a) Of the above claim(s) 1-16 and 26-42 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 17-25 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/10/04.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election of Group III in the reply filed on 1/27/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
  
2. Claims 1-16, 26-42 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/27/2005.

***Claim Objections***

3. Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is vague and indefinite due to an apparent substantial typographical error.

In claims 19, 21-23, the phrases "greater than about" and "less than about" are vague and indefinite barring a showing in the specification as to what the values around the endpoint are envisioned to be encompassed by the word "about". *Ex parte Lee*, 31 USPQ2d 1105 (BdPatApp&Int. 1993). In the instant case, Applicant have used the mathematical expression "less than about" or "greater than about" (or their equivalents). In the present case, the phrases used have exact meaning s (i.e., "greater than X" and/or "less than X") which are combined with a non-exact modifier (i.e., about). As such, the expressions are indefinite since the exact expression(s) "at least" and "less than" require(s) an exact endpoint and the modifier "about" removes that exact endpoint. Only in cases where it is clear from provided experimental data what the "about" is intended to encompass are the phrases "less than about" or "greater than about" (or their equivalents) considered definite.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by PITTS ET AL (US 5,037,702) or PITTS ET AL (US 5,024,898).

The PITTS ET AL references disclose dry erasable surfaces comprising heat-curable coatings having surface tension values of 22 dyne/cm or greater. (PITTS ET AL '702, line 63-68, col. 2; line 7-30, col. 3) (see corresponding portions of PITTS ET AL '898)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 21-23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over:

HE ET AL (US 6,476,965) or WO 01/43961 (WO '961);

in view of SWEET ET AL (US 6,620,500).

HE ET AL and WO '961 disclose a dry erase surface having a low gloss surface with a 60° gloss of less than 60, wherein the dry erase surface comprises a polyester or acrylate coating. (HE ET AL, column 2) (see corresponding portions of WO '961) However the references do not explicitly disclose thermally curable coating.

SWEET ET AL discloses that it is well known in the art to utilize thermally curable coating compositions to provide dry erasable surfaces. (line 10-32, col. 7)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use known heat-curable coating compositions as the dry erasable coating surface of HE ET AL or WO '961 in order to obtain useful erasable and reusable writing products.

7. Claims 17-20, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over: HE ET AL (US 6,476,965) or WO 01/43961 (WO '961); in view of SWEET ET AL (US 6,620,500); as applied to claims 21-23 above, and further in view of PITTS ET AL (US 5,037,702) or PITTS ET AL (US 5,024,898).

The PITTS ET AL references disclose that it is well known in the art to utilize heat-curable coatings having surface tension values of 22 dyne/cm or greater to form dry erasable layers, depending on the type of ink used to mark said erasable surfaces, in order to avoid undesirable beading. (line 63-68, col. 2; line 7-30, col. 3)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to adjust the surface tension of dry erase coatings in order to improve the markability of said coatings.

8. Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over: PITTS ET AL (US 5,037,702) or PITTS ET AL (US 5,024,898); in view of HE ET AL (US 6,476,965) or WO 01/43961 (WO '961); and in view of SWEET ET AL (US 6,620,500);

Claim 17 is also rejected under 35 U.S.C. § 102(b) as being anticipated by the PITTS ET AL references as stated above. However, in the event the claim is not anticipated, the claims are obvious for the following reasons:

The PITTS ET AL references dry erasable surfaces comprising heat-curable coatings having surface tension values of 22 dyne/cm or greater. (PITTS ET AL '702, line 63-68, col. 2; line 7-30, col. 3) (see corresponding portions of PITTS ET AL '898) However the references do not explicitly disclose the recited gloss values.

HE ET AL and WO '961 disclose that it is well known in the art to provide a dry erase surface with a low gloss surface with a 60° gloss of less than 60, wherein the dry erase surface comprises a polyester or acrylate coating in order to minimize glare and avoid eyestrain. (HE ET AL, column 2) (see corresponding portions of WO '961)

SWEET ET AL discloses that it is well known in the art to utilize thermally curable coating compositions to provide dry erasable surfaces. (line 10-32, col. 7)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to reduce the gloss of dry erase coatings in order to improve the readability of articles with dry erasable surfaces.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 19, 2006



Vivian Chen  
Primary Examiner  
Art Unit 1773